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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,732	02/03/2006	Georg Podhajsky	07781.0207-00	8294
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EXAMINER MEHTA, NANCY T				
ART UNIT 3692		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/525,732

Applicant(s)

PODHAJSKY ET AL.

Examiner

NANCY MEHTA

Art Unit

3692

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05/26/2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-9, 12-14, 17, 18, 20, 22-28, 30-33, 36 and 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-14, 16-, 3-9, 12-14, 17, 18, 20, 22-28, 30-33, 36 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 February 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-848)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Application

This office action is in response to the amendments and arguments filed by applicant on 05/26/2009.

- Claims 1, 3-9, 12-14, 17, 18, 20, 22-28, 30-33, 36, and 37 are amended
- No claims are cancelled. Claims 2, 10, 11, 15, 16, 19, 21, 29, 34, 35, and 38 were previously cancelled.
- No new claims are added.
- Claims 1, 3-9, 12 -14, 17, 18, 20, 22-28, 30-33, 36, and 37 are pending

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 14, 18, 20, 33, and 37 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 20, the applicant has amended the claims to overcome the rejection previously made under 35 U.S.C. 101; however, the amendments made by the applicant do not clearly indicate the interaction between the system claimed in the preamble of the claim and the software claimed in the limitations following the preamble. It is unclear if the software is present on the computer-platform or if the software is available externally to the computer platform claimed. In the latter case, if the software

is on a flash drive, the flash drive does not elicit a response by the computer platform and hence is not read unless it is manually accessed; while software externally available on a CD ROM, when inserted into the computer platform immediately leads the computer platform to process the addition of this new software and elicits a response.

In claims 14, 33 and 37, the applicant has amended some limitations to overcome the 101 rejection previously made. However, since only a few of the limitations have an indication that the step or process is being performed "by a computer", there is still room for interpretation that at least some of the steps or processes in the above claims can be performed manually. The examiner further notes that the applicant has added "performed by a computer" explicitly in the preamble of the claims but this has not been added to each step in the claimed method. Since, this type of claim limitation leaves room for interpretation of manual involvement, the claims are ambiguous.

Further, in the independent claims 1, 14, 18, 20, 33, and 37, the amended claim limitation "input/output means for treating said set of metadata in said repository and invoking said generation tool" is ambiguous. Such limitation is vague and indefinite. The phrase "treating said set of metadata" is vague because it is unclear what the applicant means by treating a set of data. Downloading data into a computer can be viewed as "treating a set of data" in the broadest reasonable interpretation of the terms.

The applicant is requested to provide appropriate clarifications. All the rejections that follow are based on the 35 U.S.C. 112 2nd rejections made above.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 3-9, 12 -14, 17, 18, 20, 22-28, 30-33, 36, and 37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In claims 1 and 20, the applicant has amended the claims to overcome the rejection previously made under 35 U.S.C. 101; however, the amendments made by the applicant do not clearly indicate the interaction between the system claimed in the preamble of the claim and the software claimed in the limitations following the preamble. It is unclear if the software is present on the computer-platform or if the software is available externally to the computer platform claimed. In the latter case, if the software is on a flash drive, the flash drive does not elicit a response by the computer platform and hence is not read unless it is manually accessed; while software externally available on a CD ROM, when inserted into the computer platform immediately leads the computer platform to process the addition of this new software and elicits a response.

Claims 1 and 20 are directed to a system that comprises software, however, the location of the software on the system is unclear. When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional

descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory [See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”)]. When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory. Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer [See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory)]. Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs are not physical “things.” They are neither computer components nor statutory processes, as they are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process, and as such is nonstatutory functional descriptive material.

In claims 14, 33 and 37, the applicant has amended some limitations to overcome the 101 rejection previously made. However, since only a few of the limitations have an indication that the step or process is being performed "by a computer", there is still room for interpretation that at least some of the steps or processes in the above claims can be performed manually. The examiner further notes that the applicant has added "performed by a computer" explicitly in the preamble of the claims but this has not been added to each step in the claimed method. Since, this type of claim limitation leaves room for interpretation of manual involvement, the claims are ambiguous.

Claims 14, 33, and 37 are directed towards methods that involve performance of steps but there is not computer medium to perform the steps, as such these claims are not tied to any other statutory class. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class, such as a particular apparatus, or (2) transform underlying subject matter, such as an article or materials, into a different state or thing. If neither of these requirements is met by the claim, the method is not a patent eligible process under § 101 and should be rejected as being directed to non-statutory subject matter. See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n. 9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70-71 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).
Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-9, 12 -14, 17, 18, 20, 22-28, 30-33, 36, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee, et al. [U.S. Pat. Pub. 2002/0092004].

Regarding Claim 1, Lee, et al. discloses, A business application generation system for automatically generating a business software application, comprising:

a central processing unit (Fig. 1);

a repository comprising a set of meta data, said set of meta data containing structured business process application information comprising information on functions operating on data, and said generation tool retrieving data from said repository and, on the basis of said retrieved repository data, generating a customized business process application (Fig. 1, 10, ¶10)

Lee, et al. does not explicitly disclose,

Business data

However, Lee, et al. discloses a business process application which contains data. It is obvious that the data could be considered business data;

a generation tool comprising a first tool and a second tool, said first tool being a meta data dependent passer element and said second tool being a meta data independent generating element, said generation tool generating, based on at least said set of meta data in said repository, a customized business process application for said business process (§37, 38, 40. [0007], [0022], [0041], [0045], fig. 2, # 300 shows “customization”);

input/output means for treating said set of meta data in said repository and for invoking said generation tool, said input/output means being a workbench enabling customization of said set of meta data to generate customized meta data in said repository (§29: [0007], [0022], [0041], [0045], fig. 2, # 300 shows “customization”), wherein:

said workbench enables an invocation of said generation tool by initiating an import of said customized meta data into said passer element (§37, 38, 40)

said passer element processes said customized meta data for input to said generating element, said processing comprising (§37, 38, 40):

interpreting a semantical content of said customized meta data ([0100]:
where Lee shows the ability to interpret computer program(s) ([0100]). The semantic content is interpreted as the language used to write, read, and interpret the computer program); and

translating said semantical content of said customized meta data into customized business process data for input into said generating element ([0008], [0037], [0038], [0063]); and

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said generating element generates, on the basis of said processed meta data input, program code for said customized business process application (**¶37, 38, 40**).

Regarding Claim 3, Lee, et al. further discloses, wherein said set of meta data in said repository consists of data base tables containing meta data entities.

(¶64)

Regarding Claim 4, Lee, et al. further discloses, wherein meta data entities contain information on an identification of said customized business process application, on object types and on object structures.

(¶64)

Regarding Claim 5, Lee, et al. further discloses, wherein said object types contain information on said business process data to be processed by the application and on said functions operating on said business process data.

(¶10, 64)

Regarding Claim 6, Lee, et al. does not explicitly disclose, wherein said business process is a billing process.

However, it is well known in the art at the time of the invention that a billing process is a business process.

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Regarding Claim 7, Lee, et al. does not explicitly disclose, wherein said business process is a bonus payment process.

However, it is well known in the art at the time of the invention that a bonus payment process is a business process.

Regarding Claim 8, Lee, et al. does not explicitly disclose, wherein said business process is a commission payment process.

However, it is well known in the art at the time of the invention that a commission payment process is a business process.

Regarding Claim 9, Lee, et al. further discloses, wherein said customization enabled at said workbench comprises at least one of viewing, creating, adding, deleting, changing, inheriting, and editing of said repository meta data.

(¶29)

Regarding Claim 12, Lee, et al. further discloses, wherein said generating element further generates data objects for said customized business process application.

(¶10, 64)

Regarding Claim 13, Lee, et al. further discloses, wherein said generating element further generates a data base for said customized business process application.

(¶10, 64)

Regarding Claim 14, Lee, et al. discloses, A computer-based method for generating a business software application, comprising the steps, performed by a computer, of:

providing a set of meta data comprising structured information on a business process, said structured information comprising on functions operating on business process data (**Fig. 1, 10, [0010]**);

customizing said set of meta data via an input/output means before said meta data is imported into a generation tool, said generation tool comprising a meta data dependent passer element and a meta data independent generating element for generating a customized business software application (**¶39**);

importing said customized meta data comprising information on functions into a said passer element of generation tool (**Fig. 1, 10, ¶10, 37, 38, and 40**)

processing said customized meta data imported into said generation tool in said meta data dependent passer element, wherein said processing comprises **[37-40]**:

interpreting a semantical content of said customized meta data ([0100]; **where Lee shows the ability to interpret computer program(s) ([0100]). The semantic content is interpreted as the language used to write, read, and interpret the computer program); and**

translating said semantical content of said customized meta data into customized business process data for input into said generating element ([0008], [0037], [0038], [0063]);

inputting said set of meta data after processing in said passer element into said generating element [37-40].

Lee, et al. does not explicitly disclose,

Business process data

However, Lee, et al. discloses a business process application which contains data. It is obvious that the data could be considered business process data.

Regarding Claim 17, Lee, et al. further discloses, further comprising the steps of inputting said set of meta data after processing in said passer element into said generating element, and generating program code for said business process application on the basis of said processed meta data.

(Fig. 1, 10, ¶10, 37-40)

Regarding Claim 18, Lee, et al. discloses, A computer program product comprising a computer readable storage medium, the computer readable storage medium storing instructions that, when executed by a processor, perform a method for generating a business software application, the method comprising steps, performed by the processor, of:

customizing a set of meta data via an input/output means before said meta data is imported into said generation tool, generation tool comprising a meta data dependent passer element and a meta data independent generating element (**¶39**);

importing said customized meta data into said passer element of said generation tool (**Fig. 1, 10, ¶10, 37-40**); and

on the basis of said set of meta data, processing said customized meta data in said passer element, inputting said processed meta data in said generating element and generating a customized software application based on said processed metadata, wherein said processing comprises (**Fig. 1, 10, ¶10, 37-40**):

interpreting a semantical content of said customized meta data ([0100]:
where Lee shows the ability to interpret computer program(s) ([0100]). The semantic content is interpreted as the language used to write, read, and interpret the computer program); and

translating said semantical content of said customized meta data into customized business process data for input into said generating element ([0008], [0037], [0038], [0063]);

Lee, et al. does not explicitly disclose,

Customized business software application

However, Lee, et al. discloses a business software application as well as a customized software application. It is obvious that the customized software application could be considered a business software application.

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Regarding Claim 20:

The examiner notes that claim 20 recites limitations that parallel limitations recited by claim 1 and 14, and as such, is rejected under same basis as claims 1 and 14.

Regarding Claim 22, Lee, et al. further discloses, wherein said set of meta data in said repository consists of data base tables containing meta data entities.

(¶64)

Regarding Claim 23, Lee, et al. further discloses, wherein said meta data entities contain information on an identification of said customized adapted version of existing business application, on object types and on object structures.

(¶64)

Regarding Claim 24, Lee, et al. further discloses, wherein said object types contain information on said business process data and on functions operating on said business process data.

(¶10, 64)

Regarding Claim 25, Lee, et al. does not explicitly disclose, wherein said existing business process is a billing process.

However, it is well known in the art at the time of the invention that a billing process is a business process.

Regarding Claim 26, Lee, et al. does not explicitly disclose, wherein said existing business process is a bonus payment process.

However, it is well known in the art at the time of the invention that a bonus payment process is a business process.

Regarding Claim 27, Lee, et al. does not explicitly disclose, wherein said existing business process is a commission payment process.

However, it is well known in the art at the time of the invention that a commission payment process is a business process.

Regarding Claim 28, Lee, et al. further discloses, wherein said customization enabled at said workbench comprises at least one of viewing, creating, adding, deleting, changing, inheriting, and editing of said repository meta data.

(¶29)

Regarding Claim 30, Lee, et al. further discloses, wherein said generating element generates, on the basis of said processed meta data input program code for said customized adapted version of said existing business process application.

(¶37, 38, 40)

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Regarding Claim 31, Lee, et al. further discloses, wherein said generating element further generates data objects for said customized adapted version of said existing business process application.

(¶10, 64)

Regarding Claim 32, Lee, et al. further discloses, wherein said generating element further generates a data base for said customized adapted version of said existing business process application.

(¶10, 64)

Regarding Claim 33:

The examiner notes that claim 33 recites limitations that parallel limitations recited by claim 1, 14, and 20, and as such, is rejected under same basis as claims 1, 14, and 20.

Regarding Claim 35, Lee, et al. further discloses, further comprising the step of handling, interpreting, and processing said set of meta data imported into said generation tool in said meta data dependent passer element.

(¶37, 38, 40)

Regarding Claim 36, Lee, et al. further discloses, further comprising generating program code for said customized adapted business process application on the basis of said processed meta data.

(Fig. 1, 10, ¶10, 37-40)

Regarding Claim 37,

The examiner notes that claim 37 recites limitations that parallel limitations recited by claim 1, 14, and 20, and as such, is rejected under same basis as claims 1, 14, and 20.

Response to Arguments

Argument #1

Applicant argues that the amendments made to the claim limitations overcome the 101 rejection made in the previous Office Action.

Response to Argument #1

Applicant's arguments have been fully considered; however, the examiner respectfully disagrees. Applicant's amendments made to claim 18 overcome the previous rejection made under 35 U.S.C. 101.

However, the applicant's amendments to independent claim 1, 14, 20, 33, and 37 do not overcome the rejection made under 35 U.S.C. 101.

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Argument #2

Applicant argues that Lee fails to disclose newly added claim limitations in the amended independent claims 1, 14, 18, 20, 33 and 37 "interpreting a semantical....generating element".

Response to Argument #2

Applicant's arguments have been fully considered, however, the examiner respectfully disagrees.

The examiner would like to draw applicant's attention to Lee, para [0037], "XML meta documents.....program 28", where Lee discloses the conversion of UML applications into design database files. This conversion is a modification of the application, thus Lee shows "editing" of the XML meta documents.

Also Lee shows in paragraph [0037], [0038], the generator program (28), which is the first tool, and design program (28), which is the second tool.

To further address applicant's argument, the examiner also points to paragraph [0039], where the generator program receives the XML document, processes the document by performing a series of validations on the document, and then creates a design database file and a system installation file. The system installation program further generates a generated software application. Thus the cited paragraphs read on the claim limitation "workbench enables.....passer element".

The examiner would like to further note that Lee shows interpretation of computer program(s) ([0100]). The semantic content is interpreted as the language used to write, read, and interpret the computer program.

As the remaining claims depend directly or indirectly from the amended independent claims, the examiner maintains that Lee either in obvious combination or individually clearly teaches all limitations argued and presented by the applicant in the claims as currently they have been amended.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANCY MEHTA whose telephone number is (571)270-3265. The examiner can normally be reached on Monday - Friday 9:00 am - 5:00 pm, alt. Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nancy Mehta

/Nga B. Nguyen/
Primary Examiner, Art Unit 3692